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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEN HARRIS

Appeal 2007-4471
Application 09/692,075
Technology Center 1700

Decided: June 30, 2008

Before ROMULO H. DELMENDO, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

REMAND ORDER

This appeal involves claims 26, 28, 32-36, 43, and 44. Because this application is not ready for a decision on appeal, we REMAND. The Examiner is instructed to consider the following issues and take appropriate action not inconsistent with this order.

Appellant filed an “Appellant’s Brief” (hereinafter “App. Br.,” on July 6, 2005. In that Brief, Appellant focused on claim 26 and argued four (4) grounds of rejection together (three of which did not involve claim 26).

Specifically, Appellant urged that the Examiner did not make out a prima facie case of obviousness because: (1) the Examiner did not “cite column and line number from within the cited references as to where a suggestion to combine may be found”; (2) the Examiner “used hindsight to attempt to combine 6 (and even more) references to find the present invention obvious”; and (3) “[o]ne having ordinary skill in the art would not have been motivated to practice Fan [a reference that is not even applied in one of the rejections] with materials, like polyimides, that cure at hundreds of degrees Celsius” (App. Br. 4-5).

In response to the July 6, 2005 Appeal Brief, the Examiner entered an Examiner’s Answer on September 20, 2005. In that Answer, the Examiner did not specifically address Appellant’s arguments (1) and (2), identified above. Instead, the Examiner addressed an issue *not* raised in the Brief, as follows: “Therefore the references used in the rejection of claim 26 are analogous . . .” (Sep. 20, 2005 Answer at 8).

On February 16, 2006, the Board issued an “Order Returning Undocketed Appeal to Examiner” requiring corrections to the Appeal Brief and the Examiner’s Answer.

On April 7, 2006, the Examiner issued a communication requiring “a new appeal brief with clean copies of the claims together with an after final amendment . . .” (p. 2). To this communication, the Examiner attached an Examiner’s Answer with a “Mailed” stamp of April 7, 2006. Thus, the Examiner did not wait until Appellant had an opportunity to cure the defects in the July 6, 2005 Brief.

On December 13, 2006, the Examiner issued a communication summarizing a telephone discussion with Applicant’s representative, who

informed the Examiner that “the two pages setting forth that the brief was defective and setting the period form [sic] response were not received,” and restarting the time period for response. In addition, the Examiner attached a copy of the April 7, 2006 Examiner’s Answer.

Apparently confused by the Examiner’s preemptive actions, Appellant filed a paper characterized as a “Reply Brief Under Rule 1.93(b)(1)” and as “Applicant’s Reply to the Examiner’s Answer of December 13, 2006” (page 1) on June 13, 2007.¹ In the June 13, 2007 Brief, Appellant addressed all four grounds of rejection with new arguments.

Then, for reasons not clear to us, the Examiner issued a communication mailed on July 19, 2007 stating: “The reply brief of 6/13/2007 has been received, made of record and considered by the examiner The examiner has no further response to the reply brief and relies upon the response found in the Examiner’s Answer of 09/20/06 to address the applicant’s arguments.” The problem, however, is that the Examiner did not provide us with the benefit of his rebuttal to all of Appellant’s arguments in the June 13, 2007 Brief.

Upon receipt of this application, the Examiner must issue a Supplemental Examiner’s Answer that addresses each and every argument raised in Appellant’s Briefs, providing detailed reasons as to why Appellant’s arguments are not persuasive.

As a separate matter, the Examiner continues to cite to a JPO machine-generated English language translation of JP 08-039572. This is inappropriate from at least an evidentiary standpoint because it does not rely

¹ In actuality, however, this paper was a response to a notice of defective Appeal Brief.

on the best evidence. Indeed, the machine-generated translation states in bold letters: “JPO and NCIP are not responsible for any damages caused by the use of this translation.” We therefore attach a PTO translation to this order.²

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of rejections. Accordingly, 37 C.F.R. § 41.50(a) (2) applies to any Supplemental Examiner’s Answer written in response to this Remand.

REMANDED

tf/lr

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² The Examiner should cite to this translation when addressing the Appellant’s arguments presented in the Brief.